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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,813	10/30/2003	Donald H. Osterberg JR.	88325-761206 (067000US)	2479
51206 7590 12/09/2011 Kilpatrick Townsend & Stockton LLP/Oracle Two Embarcadero Center 8th Floor San Francisco, CA 94111-3834				
EXAMINER WHIPPLE, BRIAN P				
ART UNIT 2448		PAPER NUMBER		
NOTIFICATION DATE 12/09/2011		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary****Application No.**

10/698,813

**Applicant(s)**

OSTERBERG, DONALD H.

**Examiner**

Brian P. Whipple

**Art Unit**

2448

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1, 6, 7, 9, 21, 26, 27, 29 and 30 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1, 6, 7, 9, 21, 26, 27, 29 and 30 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-886)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 6, 7, 9, 21, 26, 27, 29, and 30 are pending in this application and presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/11 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 6, 7, 9, 21, 26, 27, 29, and 30 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

4. As to claims 1 and 6, claim 1 refers to "e-mail," but claim 6 refers to "email." For the sake of consistency, the claims should refer uniformly to either e-mail or email.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 6, 7, 9, 21, 26, 27, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrigues, U.S. Publication No. 2003/0200267 A1, in view of Lalonde et al. (Lalonde), U.S. Publication No. 2004/0068542 A1.

7. As to claim 1, Garrigues discloses an unsolicited e-mail Internet protocol source address verification and tracking method (Abstract) comprising:

sending from a source device a request for authorization to send an electronic mail message ([0062]), the request identifying an address of the source of the request ([0026], ln. 1-2; [0027], ln. 3-5; [0054], ln. 19-22);

receiving at an e-mail authorization system from the source device the request for authorization to send the electronic mail message ([0063], ln. 1-4);

authorizing the request with the e-mail authorization system including generating an authorization indicator that includes the source device sending said request for authorization ([0063], ln. 16-20; [0069]);

sending a response to the request for authorization from the e-mail authorization system to the address of the source device, wherein the response to said request for authorization includes the authorization indicator ([0063], ln. 16-20; [0069]);

receiving at the source device from the e-mail authorization system the authorization indicator ([0063], ln. 16-20; [0069]);

adding by the source device the received authorization indicator to an electronic mail message ([0008]);

sending the electronic mail message with the added authorization indicator from the source device to a destination device ([0008], ln. 7-8);

receiving the electronic mail message with the added authorization indicator from the source device at an intermediate mail agent for the destination device ([0068]); and

handling receipt of said electronic mail message at the intermediate mail agent for the destination device ([0068]).

Garrigues is silent on the authorization indicator includes the address of the source device; and

sending the electronic mail message with an indication of the address of the source device; and

including comparing the indication of the address of the source device included in the received electronic mail message against the address of the source device sending said request for authorization from the authorization indicator received in the electronic mail message.

However, Lalonde discloses the authorization indicator includes the address of the source device (Fig. 5; [0039]); and

sending the electronic mail message with an indication of the address of the source device (Fig. 5; [0039]); and

including comparing the indication of the address of the source device included in the received electronic mail message against the address of the source device sending said request for authorization from the authorization indicator received in the electronic mail message (Fig. 5; [0039]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Garrigues in the aforementioned manner as taught by Lalonde in order to detect “spoofed” addresses and inform an end user, so that the end user is not taken advantage of by the sender of the spoofed address (Lalonde: [0002]; [0003]).

8. As to claim 6, Garrigues and Lalonde disclose the invention substantially as in parent claim 1, wherein said authorization indicator is a unique bit string (Garrigues: [0028]) and further identifies an address of the email authorization system (Garrigues: [0070]; [0071]).

9. As to claim 7, Garrigues and Lalonde disclose the invention substantially as in parent claim 1, further comprising tracking the address of the source device with the e-mail authorization system (Garrigues: [0030], ln. 11-14; [0055]; Lalonde: Fig. 5; [0039]).

10. As to claim 9, Garrigues and Lalonde disclose the invention substantially as in parent claim 1, wherein generating the authorization indicator comprises:

extracting a request source address from said request (Garrigues: [0026], ln. 1-2; [0027], ln. 3-5; [0054], ln. 19-22); and

generating a key uniquely identifying the source device (Garrigues: [0042]; [0049]) and based on the address of the source device indicated in the request (Lalonde: Fig. 5; [0039]).

utilizing said request source address as a destination address in a header file of a return package including authorization indicator information (Garrigues: [0063], ln. 16-20; [0069]).

11. As to claim 21, the claim is rejected for reasons similar to claim 1 above.
12. As to claim 26, the claim is rejected for reasons similar to claim 6 above.
13. As to claim 27, the claim is rejected for reasons similar to claim 7 above.
14. As to claims 29 and 30, the claims are rejected for reasons similar to claim 1 above.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Whipple whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple  
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Primary Examiner, Art Unit 2448  
12/5/11